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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,858	01/29/2004	Naoyuki Nagafuchi		2619

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MATTINGLY, STANGER & MALUR

Suite 370

1800 Diagonal Rd.

Alexandria, VA 22314

EXAMINER

SHECHTMAN, SEAN P

ART UNIT

PAPER NUMBER

2125

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/765,858

Applicant(s)

NAGAFUCHI ET AL.

Examiner

Sean P. Shechtman

Art Unit

2125

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8 and 12-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8, 12, 13 and 15-17 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/791,703.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 8 and 12-17 are presented for examination. Claims 13-17 have been added.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 13 and 15-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claim 13, it is unclear what system is intended to be referred to by the terms "same system".

Referring to claim 13, lines 6-7, it is unclear what "is operation information of said power generating facilities".

Claim 15 recites the limitation "said failure degree" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 16 recites the limitation "said failure degree" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 17 recites the limitation "said failure degree" in line 4. There is insufficient antecedent basis for this limitation in the claim.

#### ***Claim Objections***

3. Claims 13, 16, 17 are objected to because of the following informalities:

Referring to claim 13, line 8, "requiring" should be rephrased "repairing".

Referring to claim 13, lines 11-12, “load following is able to perform according to other than said power generating facility” should be rephrased “load following is able to be performed according to at least one of said power generating facilities other than said power generating facility”.

Referring to claim 16, line 6, “load following is able to perform” should be rephrased “load following is able to be performed”.

Referring to claim 17, lines 6 and 9, “load following is able to perform” should be rephrased “load following is able to be performed”.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pub. No. 2002/0035497 to Mazereeuw (supplied by applicant) in view of U.S. Pat. No. 4,469,954 to Maehara.

Referring to claim 8, Mazereeuw teaches a method of maintaining and managing a plurality of power supplying facilities which supply power to arbitrary power systems (Fig. 1, elements 106 and 128; Page 1, paragraph 0002, 0003, and 0010; Page 3, paragraph 0024; Page 5, paragraph 0039), comprising the steps of:

receiving information of a failure which has occurred in at least one of said power supplying facilities, through communication means (Page 3 - Page 4, paragraph 0028),

selecting a repairing period and procedure for said failure, from repairing periods and procedures which are predetermined according to levels of failures (Page 4, paragraph 0029-0034; The fault conditions are described in levels as service warnings, emergency warnings, and no warning), and

outputting an instruction to control the operation of at least one of the power supplying facilities other than the power supplying facility in which said failure has occurred according to the selected repairing period and procedure (Page 5, paragraphs 0036 and 0039).

Referring to claim 12, Mazereeuw teaches an obtaining failure information of a power supplying facility which has a failure from an error supervision/diagnosis means (Page 4, paragraph 0033; see page 3, paragraphs 0021-0024 for description of supervisory control and data acquisition, i.e. "SCADA". The monitoring system may be directly equipped with the SCADA, page 3, paragraph 0024),

comparing actual operation data of said power supplying facilities by normal and abnormal operation data which was stored in a database in advance (Fig. 1, element 128; Page 3, paragraph 0024 and 0028; Page 4, paragraph 0029, 0032, and 0034; Page 5, paragraph 0039, the expertise database may be a passive or an interactive database of fault events, symptoms, and solutions), checking for any operation error by an error supervision/diagnosis means (Page 3 – Page 4, paragraph 0028; i.e., the servers query the substation to determine when a fault is detected), outputting failure information from said error supervision/diagnosis means when finding an operation error (Page 4, paragraph 0030; The servers notify appropriate personnel),

determining the level of said failure by a fault level judge from said output failure information (Page 4, paragraphs 0031 and 0032; The server automatically calls up appropriate information from the equipment database that relates to the particular fault condition), and showing a predetermined repairing period and procedure according to the determined fault level (Page 4, paragraph 0030).

Although the invention of Mazereeuw teaches monitoring a utility substation or substations rather than a utility generator. The examiner respectfully submits that, with respect to the claims as such, monitoring a utility substation and monitoring a utility generator are considered to be functionally equivalent. It has been held that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In this case, the structure of Mazereeuw is capable of monitoring a utility generator.

However, Mazereeuw teaches all of the claim limitations set forth above, however, fails to teach that the substations are capable of generating power.

However, referring to claims 8 and 12, Maehara teaches analogous art, with a substation capable of generating power (Abstract; Cols. 1-2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time that the invention was made to combine the teachings of Maehara with the teachings of Mazereeuw.

One of ordinary skill in the art would have been motivated to combine these references because Maehara teaches a substation that can be used in areas where no power supply for operating and controlling the equipment is available, thereby resulting in the increased usability of the substation (Col. 2, lines 37-43). Furthermore, the substation can start itself up and does not have to rely on or be located near an electric power source (Abstract; Col. 1, lines 13-45).

***Allowable Subject Matter***

5. Claim 13 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 15-17 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

The following is a statement of reasons for the indication of allowable subject matter:

While Mazereeuw teaches immediate dispatch in response to a fault indicated to be an emergency warning (Page 4, paragraph 31), and Mazereeuw teaches outputting an instruction to control the operation of at least one of the power supplying facilities other than the power

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supplying facility in which said failure has occurred according to the selected repairing period and procedure (Page 5, paragraphs 0036 and 0039).

And Machara teaches a substation that can be used in areas where no power supply for operating and controlling the equipment is available, thereby resulting in the increased usability of the substation.

Referring to claim 13, neither of these references taken either alone or in obvious combination teach method or system of managing a plurality of power generating facilities having all the claims features of applicants instant invention, specifically including: “controlling a rise in loads of other than said power generating facility, when a load following is able to be performed according to at least one of said power generating facilities other than said power generating facility during an instruction to control the operation of at least one of said power generating facilities other than said power generating facility in which said failure has occurred, according to said selected repairing period and procedure”.

Referring to claim 14, neither of these references taken either alone or in obvious combination teach method or system of managing a plurality of power generating facilities having all the claims features of applicants instant invention, specifically including: “when said failure is a heavy failure, said failure power generating facility is interrupted according to a plant automatic interrupting function, and from said plant automatic interrupting function, interrupting information of said failure generating facility is transmitted to a scheduling function”.

Referring to claim 15, neither of these references taken either alone or in obvious combination teach method or system of managing a plurality of power generating facilities having all the claims features of applicants instant invention, specifically including: “a plant



automatic interrupting function for instructing an interruption of said failure generating facility, when said failure degree is a heavy failure, and a scheduling function for receiving interruption information of said failure generating facility from said plant automatic interrupting function”.

Referring to claim 16, neither of these references taken either alone or in obvious combination teach method or system of managing a plurality of power generating facilities having all the claims features of applicants instant invention, specifically including: “a plant automatic interrupting function for instructing an interruption of said failure generating facility, when said failure degree is a heavy failure, and an operation state judging means in the same system for judging whether or not a load following is able to perform in the same system of said power generating facilities”.

Referring to claim 17, neither of these references taken either alone or in obvious combination teach method or system of managing a plurality of power generating facilities having all the claims features of applicants instant invention, specifically including: “a plant automatic interrupting function for instructing an interruption of said failure generating facility, when said failure degree is a heavy failure, an operation state judging means in the same system for judging whether or not a load following is able to perform in the same system of said power generating facility, and an operation state judging means in another same system for judging whether or not a load following is able to perform in said another system of said power generating facility”.

### ***Response to Arguments***

6. Applicant's arguments filed February 15<sup>th</sup> 2006 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Maehara teaches a substation that can be used in areas where no power supply for operating and controlling the equipment is available, thereby resulting in the increased usability of the substation (Col. 2, lines 37-43). Furthermore, the substation can start itself up and does not have to rely on or be located near an electric power source (Abstract; Col. 1, lines 13-45).

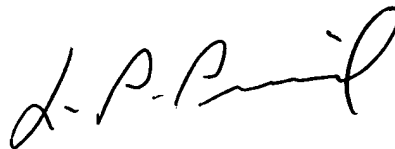
In response to applicant's argument that Maehara is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Maehara, Mazereeuw, and Applicant's invention are all in the field of power generation systems.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean P. Shechtman whose telephone number is (571) 272-3754. The examiner can normally be reached on 9:30am-6:00pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo P. Picard can be reached on (571) 272-3749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SPS

Sean P. Shechtman

April 27, 2006

**LEO PICARD  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100**